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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/988,181	12/10/1997	SHINICHI OSHIMA	Q48708	7161

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WASHINGTON, DC 20037

EXAMINER

GORDEN, RAEANN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/988,181  
Filing Date: December 10, 1997  
Appellant(s): OSHIMA, SHINICHI

**MAILED**  
**OCT 20 2006**  
**GROUP 3700**

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Bhaskar Kakarla  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 20, 2006 appealing from the Office action mailed September 21, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application 09/060,960, affirmed by BPAI (3/19/03)

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (1,676,975). Anderson discloses a golf ball box comprising a box body and a cover or lid fitted over the box (item 15, fig. 1). The box further includes indicia printed on the box explaining the novelty of the box or advertising. Applicant also claims indicia on a box. However, the indicia are not considered patentable because it is not functionally related to the substrate (box). See *In re Miller* 164 USPQ 46. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art, see MPEP 2112.01 III. One of ordinary skill in the art would vary the indicia on the box to convey the desired message to the user.

#### **(10) Response to Argument**

The instant invention is a golf ball box comprising a cover and section on the cover comprising indicia. The indicia provides information to the user with regard to product inside the box, which in the instant case is a golf ball. As stated by Appellant, the application has been reviewed and reversed by the BPAI. However, new prior art is cited and applied against the claims. Anderson et al discloses a golf ball box for packaging golf balls. The box includes a cover and indicia on the surface of the cover as shown in figure 2. The indicia provides information about the product inside the package, see figure 2 where the indicia reads 'golf ball' etc. The question before the

BPAI is whether or not the indicia is functionally related to the product. MPEP 2112.01 III states, 'Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)'. In order to interpret MPEP 2112.01 III indicia and a product must be present. In the instant case Appellant claims a box but does **not** claim the golf ball inside the package. Therefore the product to which the indicia must be functionally related to is the box. As shown in the claims the indicia is only focused on the golf balls or objects inside the box and not the box itself. Since the indicia does not provide information with regard to the claimed product it should not be considered functional. While Appellant's claims are very intricate and detailed they do not mention the claimed product or box. Appellant argues the indicia provides information about the golf balls (not the box) allowing the consumer to choose the best golf ball suited for him or her. Anderson also includes indicia providing information to the user just as any other box containing products, such as a food box comprising nutritional facts or ingredients. The indicia is not functionally related to the box but simply describes the product inside the box.

Appellant further argues *In re Gulack* 703 f.2d 1381 (Fed Cir. 1983) supports the instant invention by stating, "the critical question is whether or not there exists any new and unobvious functional relationship between the printed matter and the substrate.". Again the printed matter in the instant case does not provide any information with regard to the substrate or box.

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In conclusion, it is submitted the instant the instant invention comprising a golf ball box and indicia is not patentable over Anderson. Anderson discloses a golf ball box comprising indicia. It is further submitted the indicia is not functional to the substrate or box and should not be given patentable weight.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

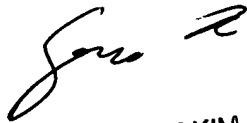


**RAEANN GORDEN  
PRIMARY EXAMINER**

Conferees:



**VISHU MENDIRATTA  
PRIMARY EXAMINER**



**EUGENE KIM  
SUPERVISORY PATENT EXAMINER**

October 13, 2006

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

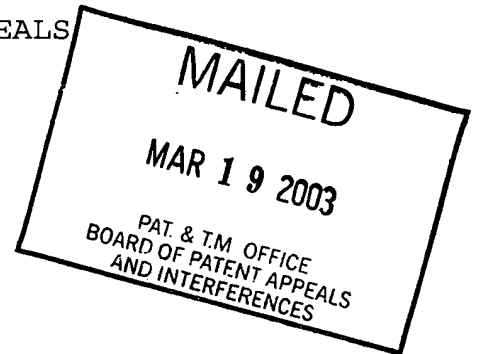
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte SHINICHI OSHIMA  
and MASAYUKI MIYAUCHI

Appeal No. 2002-2175  
Application No. 09/060,960

Heard: March 4, 2003



Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Shinichi Oshima et al. appeal from the final rejection (Paper No. 26) of claims 1 through 5, all of the claims pending in the application.

The record (see page 1 in the main brief, Paper No. 33) indicates that this appeal is related to a parallel appeal in Application No. 08/988,181 (Appeal No. 2002-1912).

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### THE INVENTION

The invention relates to a golf glove package which is defined in representative claim 1 as follows:

1. A package for a golf glove comprising:

a package capable of containing a golf glove;

a generally rectangular indication section disposed on a side of said package for indicating salient characteristics of the golf glove contained within said package, said section being divided into a plurality of subsections, each subsection indicating a unique salient characteristic of the golf glove; and

identifying means disposed within each of said subsections and comprising text and graphical indications for uniquely identifying said salient characteristics of the golf glove.

### THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Connell	1,406,541	Feb. 14, 1922
West	2,051,665	Aug. 18, 1936

Official Notice implicitly taken by the examiner of the prior art practice of packaging golf gloves in containers or boxes for distribution to consumers (conventional golf glove package).

### THE REJECTIONS

Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Connell.



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Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being obvious over Connell.

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being obvious over Connell in view of West.

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being obvious over a conventional golf glove package in view of Connell.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 33 and 35) and to the examiner's answer (Paper No. 34) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

#### DISCUSSION

##### I. Grouping of claims

On page 4 in the main brief, the appellants state that "[c]laims 1-5 stand or fall together." In accordance with this statement, and pursuant to 37 CFR § 1.192(c)(7), we shall decide the appeal with respect to each of the examiner's rejections on the basis of independent claim 1 alone. In other words, dependent claims 2 through 5 shall stand or fall with claim 1 for each rejection.

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II. The 35 U.S.C. § 102(b) rejection based on Connell

Connell discloses "a label adapted or suited for containers holding any of different types of articles" (page 1, lines 77 through 79), and more specifically "a label suitable for cartons or boxes in which may be packed any of a variety of styles or shapes of smoking pipes, the label being adapted for designating the characteristics of a particular style of pipe or pipes contained in any given box or carton" (page 1, lines 11 through 17). Figure 1 shows the label as comprising a label body 10 bearing (1) pictorial representations 11 of various styles of pipes made and marketed by the manufacturer, (2) indicia such as a star 13 within the representation of the particular style of pipe packaged in the carton, (3) a space 14 with a descriptive representation 15, e.g., the word "Poker," and the star indicia 16 of the packaged pipes, (4) a space 17 with the word "Quantity" and the number of pipes, e.g., 100, in the carton, (5) spaces 20 and 21 with a trade number and trade name representative of the physical characteristics of the packaged pipes, (6) a central space 22 with the trade mark 23 of the manufacturer on a background color-coded to denote the price of the packaged pipes, and (7) a space 24 with the name of the manufacturer on a like

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color-coded background. Connell teaches that this label serves to quickly and accurately convey the identity and characteristics of the articles packaged in the box or carton (see Connell at page 1, lines 8 through 94).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

As indicated above, claim 1 recites a golf glove package comprising, inter alia, "identifying means disposed within each of said subsections and comprising text and graphical indications for uniquely identifying said salient characteristics of the golf glove." While not disputing that Connell fails to meet these limitations, the examiner dismisses them as being directed to printed matter whose content does not impart patentable weight to the claimed invention (see page 8 in the answer).

The examiner's position here is untenable. Differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04

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(Fed. Cir. 1983). Since Connell does not disclose a package meeting the identifying means limitations in claim 1, it is not anticipatory with respect to the subject matter recited therein.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1, and dependent claims 2 through 5, as being anticipated by Connell.

III. The 35 U.S.C. § 103(a) rejection based on Connell

Acknowledging that Connell does not meet the golf glove identifying means limitations in claim 1, the examiner nonetheless concludes that

one skilled in the art, looking at the package and label combination in the Connell device and noting the context within which the package and label are used, would have been motivated to use a similar package and label embodiment to provide information to a consumer regarding any number of packaged products [including, presumably, a packaged golf glove] [answer, page 4].

The examiner, however, has failed to advance in this rejection any prior art golf glove packaging evidence which supports this conclusion.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2 through 5, as being obvious over Connell.

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IV. The 35 U.S.C. § 103(a) rejection based on Connell in view of West

West discloses a container label displaying lettering and a symbol indicative of the character of the container's contents. In the illustrated example, the label includes the word "Poison" and the skull and crossbones symbol.

In proposing to combine Connell and West to reject claim 1, the examiner submits that

[i]n view of the patent to West, it would have been obvious to modify the device in the cited art reference to Connell by providing both text and graphical indicia on the exterior label(s) found on the container, the motivation being to provide concise and accurate information as to the contents of the package. As for the identifying means being indicative of the salient characteristics of a golf glove, such would flow logically from the teachings in the art [answer, page 5].

As was the case with the preceding rejection, the examiner has not advanced any prior art golf glove packaging evidence which supports this conclusion.

Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2 through 5, as being obvious over Connell in view of West.

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VI. The 35 U.S.C. § 103(a) rejection based on a conventional golf glove package in view of Connell

In this rejection, the examiner's conclusion of obviousness rests on the following rationale:

[i]t is a fact that gloves as well as other golf accouterments are often packaged in containers for ease of distribution. One need only look to the myriad of golf products such as shoes, tees, golf balls, and even golf clubs which are commonly transferred to the consumer in some type of container, i.e., a box. Now, taking into account the teachings of Connell, the skilled artisan would have realized that packaged goods could more easily be identified without disturbing the package by attaching a label with descriptive matter and graphical icons relating to the packaged item. The extension of this teaching by Connell to include any packaged good for retail sale would have been obvious. . . . Thus, to have modified a conventional box already housing gloves to include further facts about the glove which a manufacturer may deem helpful to a consumer during the selection and buying process and which a manufacturer feels may help better educate the consumer about his product would have been obvious to the skilled artisan at the time the invention was made [answer, pages 5 and 6].

In what appears to be an alternative approach to the rejection, the examiner also submits that "the mere fact that the claimed identifying means are confined to distinguishing a golf glove from other articles that may be housed within the package does not patentably distinguish the claimed invention over the

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prior art. The claimed identifying means are simply deemed to be printed matter" (answer, page 6).

This latter position is unsound. Where printed matter is not functionally related to its substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In re Gulack, supra. Although the printed matter must be considered, in that situation it is not be entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id.

In the present case, a functional relationship clearly exists between the printed matter (the text and graphical indications identifying salient characteristics of the golf glove) and the substrate (the golf glove package). Thus, the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight in assessing the obviousness of the claimed invention.

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As for the teachings of the applied prior art, Connell's disclosure of a label designed to quickly and accurately convey the identity and characteristics of articles packaged in a box or carton would have furnished the artisan with ample suggestion or motivation to apply such a label to a conventional golf glove package for the same reasons, thereby arriving at the particular package set forth in claim 1. The appellants' arguments to the contrary are not persuasive.

More particularly, the disclosed presence on Connell's label of text and graphics indicative of the style, physical characteristics, price and manufacturer of the articles within the box or carton belies the appellants' contention (see, for example, pages 4 through 7 in the main brief) that Connell teaches a universal label which does not provide information about the characteristics of the pipes in the package. Although Connell's label has a universal aspect in that it displays pictorial representations of other articles made by the manufacturer, such additional information is not excluded by, or otherwise inconsistent with, the limitations in claim 1. This disclosure by Connell also refutes the appellants' argument (see, for example, pages 6 and 8 in the main brief) that Connell's



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label does not provide information about multiple characteristics of the articles within the box or carton. Claim 1 defines the indicated or identified characteristics as "salient" characteristics which, under the broadest reasonable interpretation of this term consistent with the appellants' specification, encompasses the characteristics contemplated by Connell. In this regard, the term "salient" does not require the recited characteristics to be "performance" characteristics as seemingly urged by the appellants. Finally, and notwithstanding the appellants' comments to the contrary (see, for example, pages 6 and 8 in the main brief), Connell's rectangular label (see Figure 1) and the various representations and spaces thereon constitute a generally rectangular indication section divided into a plurality of subsections as broadly recited in claim 1. At least some of these subsections, e.g., spaces 14, 22 and 24, embody text and graphical indications identifying "salient" characteristics of the articles within the package.

In light of the foregoing, the examiner's application of a conventional golf glove package and Connell justifies a conclusion that the differences between the subject matter recited in claim 1 and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and claims 2 through 5 which stand or fall therewith, as being obvious over a conventional golf glove package in view of Connell.

#### SUMMARY

Since one of the examiner's four rejections of claims 1 through 5 is sustained, the decision of the examiner to reject these claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

*Charles E. Frankfort*  
CHARLES E. FRANKFORT  
Administrative Patent Judge

*Lawrence J. Staab*  
LAWRENCE J. STAAB  
Administrative Patent Judge

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